



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/519,198

12/23/2004

Ken Yoshimura

Q85156

4526

23373 7590 06/20/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

HU, HENRY S

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

06/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,198	Applicant(s) YOSHIMURA ET AL.	
	Examiner HENRY S. HU	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS of September 19, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9-19-2005 and 12-23-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

1. It is noted that Applicants' **two IDS**' (1 page each) are filed so far. This Application is a **371/PCT/JP03/07704**. **No pre-amendment is applied.** **Claims 1-27 with a total of four independent claims** (Claims 1, 18, 23 and 24) are now pending. An action follows.

DETAILED ACTION

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner as well as by examining the references cited in international search report and IDS filed by Applicants. It is noted that all four independent claims are marked with an underline and are combined with its dependent claims.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted as following: It is noted that **four independent claims are marked with an underline**

I. **Claims 1-17 and 26-27**, drawn to **a laminated membrane** (Claims 1-17) and its **fuel cell** product (Claims 26-27). The laminated membrane comprises two components including: (A) **a membrane (I)** which comprises aromatic polymer electrolyte containing a super

strong acid group and (B) **a membrane (II)** which comprises one electrolyte selected from the group consisting of perfluoroalkylsulfonic acid polymer electrolytes and non-super strong acid polymer electrolytes.

II. **Claims 18-22 and 26-27**, drawn to **a different laminated membrane** (Claims 18-22) and its **fuel cell** product (Claims 26-27). The different laminated membrane comprises two different components including: (A) **a membrane (III)** which comprises a perfluoroalkylsulfonic acid polymer electrolyte and (B) **a membrane (IV)** which comprises a non-super strong acid polymer electrolyte.

III. **Claim 23**, drawn to **a method of producing a laminated membrane**, comprising **applying a solution of aromatic polymer containing a super strong acid group on a membrane (II)**, which comprises one electrolyte selected from the group consisting of perfluoroalkylsulfonic acid polymer electrolytes and non-super strong acid polymer electrolytes, and drying this.

IV. **Claims 24-25**, drawn to **a different method of producing a laminated membrane**, comprising **applying a solution of a perfluoroalkylsulfonic acid polymer on a membrane (IV)**, which comprises a non-super strong acid polymer electrolyte, and drying this.

3. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “**special technical features**” shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

4. In view of Examiner’s own prior art search as well as the references or articles cited in two **IDS**’ filed so far by Applicants, **Claims 1-27** is either obvious or anticipated by following: **JP 2002-8447 A, JP 2000-340031 A, JP 11-135136 A, JP 7-135004 A and JP 2002-298867 A** (all five JP patents are cited as “X” or “X/P” references in the international search in Applicants’ two priority documents **WO 2004/004037 A1 and EP 1,519,435 A1**), each individually or in combination. In summary, these four groups have no common features in the preparation as well as its application since they are structurally different. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, the laminated membrane does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate.

5. With respect to the fact that “all groups are structurally different each other”, Groups I and II was each drawn to a product such as laminated membrane, while Groups III and IV was each drawn to a different subject matter such as the process of making. It is noted that the laminated membranes made by Group III or IV may not be necessarily equivalent to the membranes mentioned in Groups I or II. In a very close examination, impregnating method is used in the process of making for Groups III or IV. The process of Group III is at least somewhat different from the process of Group IV.

Although the subject matter from each group may comprise the same or at least similar type starting ionomer, its structure, function and application are indeed different. Particularly membranes I and II are used in Group I, while membranes III and IV are used by Group II. They are thereby not interchangeable.

6. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. It is noted that no phone call was made to **John T. Callaham (registration # 32,607, tel: 202 293-7060)** by the examiner to request an oral election to the above restriction requirement due to the complexity on multiple (**four**) distinct groups along with **four** independent claims.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

10. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Vasu Jagannathan, can be reached on (571) 272-1119. The **fax** number for the

organization where this application or proceeding is assigned is **(571) 273-8300** for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

//Peter D. Mulcahy//
Primary Examiner, Art Unit 1796

/Henry S. Hu/
Examiner, Art Unit 1796

June 17, 2008